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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/018,148                           | 04/10/2002  | Hiroshi Ono          | 01764/LH            | 7036             |
| 1933                                 | 7590        | 11/03/2004           | EXAMINER            |                  |
| FRISHAUF, HOLTZ, GOODMAN & CHICK, PC |             |                      | BENENSON, BORIS     |                  |
| 767 THIRD AVENUE                     |             |                      | ART UNIT            |                  |
| 25TH FLOOR                           |             |                      | PAPER NUMBER        |                  |
| NEW YORK, NY 10017-2023              |             |                      | 2836                |                  |

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                            |  |
|------------------------------|-------------------------------|----------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/018,148 | Applicant(s)<br>ONO ET AL. |  |
|                              | Examiner<br>Boris Benenson    | Art Unit<br>2836           |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Detailed Actions***

1. Amendment received on 8/11/2004 is entered. Claims 1-7 are cancelled. Claims 8, 9, 13, 15, 16 and 19 are amended. New Claims 20-24 are entered. Claims 8-24 are pending in the Application.

***Response to the arguments***

2. Applicants argue that Ogawa et al. (JP 2000-312253) has a publication date of November 7, 2000 and the current Application claims priority of JP 2000-114912 as of April 17, 2000 and the priority of JP 2000-127191 of April 27, 2000. Examiner concludes that Ogawa et al. filed their application in Japan on April 28, 1999 before current Application has claimed priority nevertheless Ogawa et al. (JP 2000-312253) has not been published in this or foreign country and cannot be used against the Applicants.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The argument is convincing and rejection of Claims 8-19 under 35 U. S. C. 103 over Ogawa et al. is withdrawn.

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Applicant argues that "converting the energy of the magnetic field into thermal energy", which "is not specifically described in present application" and "is not feature that is claimed" should be considered. Applicant fail to indicate what specific limitation related to such feature is missing in the prior art. Examiner does not see a relevance of reference to MPEP § 706.02 (f). The argument is not convincing.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 8-10,12-19, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (6,430,217) in view of Shigeta et al. (5,207,841) and Uchida et al. (6,143,406).

Suzuki et al. disclose a Noise Eliminated Digital Wireless Transceiver Apparatus design "to provide a digital wireless transceiver such as a digital portable telephone device which is

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free from noises occurring in a headset that is connected thereto" (Col.2, Lines 8-11). The apparatus includes a headset (Fig.2, Pos.60) read on an earphone. The earphone comprises a headphone (Fig.2, Pos. 61), a microphone (62), a signal cable (64, 66), and a plug (67, 65)). The apparatus includes a low-pass filter for suppressing a high-frequency current (46). In one of embodiments the low-pass filter (LPF) "is replaced by a bead core (Fig.4, Pos. 55). The bead core 55 is made of a magnetic material such as a ferrite and is shaped like a bead. The bead core 55 blocks a passage of a high-frequency signal through a conductor" (Col. 6, Lines 20-23). In different embodiment (Fig. 5) the "the bead core 55 is located in the plug 65 of the headset 60" (Col.6, Lines 45-46) so the signal cable is covered by the low-pass filter for suppressing a high-frequency current read on a high-frequency current suppressor. Suzuki et al. disclose: "While the embodiments described above have referred to a portable-telephone device using a headset that includes a headphone and a microphone, the present invention can be applied to a headset having only a microphone.

While, further, in the embodiments described above, the headset includes two respective plugs for transmission and reception, a headset having only one plug of dual-purpose may be utilized" (Col.7, Lines 3-10). Therefore it should be understood

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that the high-frequency current suppressor could be provided in any location between a headset and an amplifier (including housing of connector or headphone or microphone).

Suzuki et al. did not disclose a type of magnetic materials to be used in forming the bead core (55) and how to make such materials.

Uchida et al. (6,143,406) teach a magnetic composite tape read on thin film "for inhibiting radiation noise includes a magnetic band member including magnetic powders and at least one of a rubber or a flexible resin and a metal foil having a width that is greater than the width of the magnetic band member, wherein the metal foil is integrally provided on a surface of the magnetic band member" (Col.1, Line 67 - Col.2 Line 5).

Uchida et al. teach use of a "material which may be made of at least any one of copper, nickel, or aluminum, for example, as a component" (Col.2, Lines 27-28). Uchida et al. teach also use of materials comprising "a rubber or a flexible resin and ferrite magnetic powders" (Abstract). Shigeta et al. teach a Soft Magnetic Powder And Magnetic Shield Composition. Shigeta et al. teach and claim "A soft magnetic powder for use in magnetic shields comprising flat soft magnetic particles of an ally having a composition defined and encompassed by polygon JKLMN in a ternary composition diagram of Fe, Si, and Al" (Claim 6).

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Shigeta et al. teach how to make a composite magnetic material "for use in magnetic shields. The flat soft magnetic particles are prepared by furnishing alloy particles having a predetermined composition, flattening them, and heat treating the flat particles to develop a peak corresponding to plane index (002) in an X-ray diffraction diagram thereof" (Abstract). Shigeta et al. teach also that "The additional elements are not particularly limited and may be selected from metal elements, typically transition metal elements and metalloid elements, for example, Ti, Zr, Nb, Ta, V, Mn, Mo, W, Co, Ni, Cu, Cr (for Fe-Si-Al system), Y, lanthanides, B, C and P. The content of additional elements is preferably 10 atom% or less, provided that the total of Fe, Si, and Cr or Fe, Si, and Al is 100 atom%" (Col.6, Lines 16-26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the low-pass filter of Suzuki et al. with teachings of Uchida et al. and Shigeta et al., because use of materials, recommended by Suzuki et al. or Uchida et al. will suppress the noise in desired frequency range and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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5. Claims 11, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (6,430,217) in view of Shigeta et al. (5,207,841) and Uchida et al. (6,143,406) as applied to claims 8-10,12-19, 23-24 above, and further in view of Osada et al. (5,703,557).

Suzuki et al. (6,430,217) in view of Shigeta et al. (5,207,841) and Uchida et al. (6,143,406) did not disclose a shape and a physical structure of the high-frequency current suppressor except of indicating that it may be located inside the connector plug and that signal wire is surrounded by the filter. Osada et al. teach a noise-absorbing device. The device comprises a flexible member (Fig. 1, Pos. 10) capable of being attached to a cable. A flexible core holder comprises a break, which elongates over all length along an axial direction of a cable. The device comprises at least two layers, which consist of a high-frequency suppressing layer (Fig. 2, Pos. 20) and a holder (10) that made of insulating resin. The device is attached around the cable and therefore the device covers all a conductors comprising the cable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified device of Suzuki et al. with teaching of Osada et al., because it will allow attach the filter in any



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desired location on the signal cable including a housing of comprising elements (plug, earphone or microphone).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris

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Benenson whose telephone number is (571) 272-2048. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571) 272-2800 x 36. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Boris Benenson  
Examiner  
Art Unit 2836

B.B.



**BRIAN SIRCUS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**